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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,677	06/19/2000	Raviv Laor	56354-018 (LAOL-116/PT)	3948

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/595,677

Applicant(s)

LAOR, RAVIV

Examiner

Stephen M Gravini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 12 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- ☐ Interview Summary (PTO-413) Paper No(s). _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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DETAILED ACTION

Requirements for Information

37 CFR 1.105 states: (a) (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

- (i) Commercial databases : The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.
- (ii) Search : Whether a search of the prior art was made, and if so, what was searched.
- (iii) Related information : A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.
- (iv) Information used to draft application : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

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(v) Information used in invention process : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) Improvements : Where the claimed invention is an improvement, identification of what is being improved.

(vii) In Use : Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(2) Where an assignee has asserted its right to prosecute pursuant to 3.71(a) of this chapter, matters such as paragraphs (a)(1)(I), (iii), and (vii) of this section may also be applied to such assignee.

(3) Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section

will be governed by §§ 1.135 and 1.136.

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The Office is requiring submission of information reasonably necessary to properly examine and treat the claimed subject matter under Rule 105. Of particular interest is information used in drafting the present operation, business practices used by applicant's professional business ventures, to show the information used in the invention process, and identification of any use of the claimed invention known to the inventor at the time the application was filed notwithstanding the date of the use.

Claim Rejections - 35 USC § 101

Claims 12-20 are rejected under 35 U.S.C. 101 because the claimed method does not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998). The independently claimed invention is an abstract idea which can be performed without interaction of a physical structure. The independently claimed steps of establishing and transferring data do not require structural interaction or mechanical intervention such that the invention falls within the technological arts permitting statutory protection. Thinking and speaking such that the claimed steps can be performed without a physical structure or mechanical object can perform the establishing and transferring data steps. Because the independently claimed invention is directed to an abstract idea and does not require structural interaction or mechanical intervention, it does not produce a useful, concrete and tangible result, is not permitted under 35 USC 101 as being related to non-statutory subject matter. Furthermore each of the claimed steps can be completely performed by a human, which further illustrate

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that the independently claimed invention is directed to an abstract idea and does not require structural interaction or mechanical intervention. The dependently claimed invention is also rejected since those claims are dependent upon what is considered non-statutorily permitted subject matter. However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are statutorily permitted.

Claim Rejections - 35 USC § 112

Claims 1-27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case, the independently claimed method and system including the steps of establishing and transferring data (including means steps thereof) are not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The independently claimed steps of specifically reciting features of data representative of one or more terms and statistics of one or more item promotions and of being selectively coupleable including a promotion code with data representative of the terms and statistics of promotions are considered non-enabling because the specification does not provide a concrete example or illustrating of those claimed steps. The specification discusses these claimed concepts but does not enable one skilled in the art how the data representative of one or more terms and statistics of one or more

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item promotions is enabled or how being selectively coupleable including a promotion code with data representative of the terms and statistics of promotions is enabled, such that one would know how to make and/or use the invention. However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are reasonably conveyed to those skilled in the art.

Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed method and system including the steps of establishing and transferring data (including means steps thereof) fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed steps of specifically reciting features of data representative of one or more terms and statistics of one or more item promotions and of being selectively coupleable including a promotion code with data representative of the terms and statistics of promotions are considered indefinite because the claims do not provide an antecedent basis of those claimed steps. The specification discusses these claimed concepts but does not particularly point out and distinctly claim the subject matter which applicant regards as the invention because it is considered that how the data representative of one or more terms and statistics of one or more item promotions is indefinite or it is considered that how being selectively coupleable including a promotion code with data representative of the terms and statistics of promotions is also indefinite. However in order to examine the claimed invention in light

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of the prior art, further rejections will be made on the assumption that those claims are not indefinite.

Claim Rejections - 35 USC § 102

Claims 1-27 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nichtberger et al. (US 4,882,675), Humble (US 4,949,256), von Kohorn (US 5,128,752), Off et al. (US 5,173,851), Ferguson et al. (US 5,256,863), Filepp et al. (US 5,347,632), de Lapa et al. (US 5,353,218), Weinblatt (US 5,401,946), Carles (US 5,515,098), Deaton et al. (US 5,644,723), Christensen et al. (US 5,710,886), Bezos (US 5,715,399), Reilley et al. (US 5,740,549), Herz et al. (US 5,754,939), Golden et al. (US 5,761,648), Walker et al. (US 5,794,207), O'Brien et al. (US 5,832,457), Gerace (US 5,848,396), Jovicic et al. (US 5,855,007), Harrison (US 5,878,222), Fajkowski (US 5,905,246), or Gregory (US 5,909,673), and are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Angles (US 5,933, 811), Merrimen et al. (US 5,948,061), Krishnamurthy (US 5,956,027), Scroggie (US 5,970,469), Guiliani et al. (US 5,974,399), Jermyn (6,026,370), Eggleston et al. (US 6,061,660), Hoyle (US 6,141,010), or Simons et al. (US 6,230,143).

Claim Rejections - 35 USC § 103

Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal experience of a method and system for telephone

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transactions from a Performance Bike Company (hereinafter Performance) sales catalog. Since at least 1994, examiner has experienced the method and system of Performance offering promotions associated with a store and commercially coupleable sales via a telephone such that each sales catalog contains a promotion code for shopper discounts. The claimed recitation including an authorization code, valuation and statistics of redeemed promotions, data display, and enablement. The claimed invention has been performed except for the recited servers, computer processors, and internet which are considered automated features of what is old and well known.

Examiner takes Official notice that it is old and well known to those skilled in the art of a method and system for managing promotions over a network, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the expressed teachings of the examiner's experience. Furthermore examiner experience teaches the claimed invention except for the claimed automated features, such that the claimed invention is considered merely an automated feature of a concept that is old and well known as discussed above. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. The motivation to combine applicants claimed invention with the services offered by Performance is to allow advertisers greater consumer targeting capabilities through electronic mediums, while transferring electronic information, which clearly shows the obviousness of the claimed invention.

Double Patenting

Claims 1-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,041,309 or over claims 1-14 of U.S. Patent No. 6,076,069. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented term electronic coupon is an obvious variation over the presently recited promotion.

Claims 1-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 09/573,279 or over claims 1-34 of copending Application No. 09/573,706 or over claims 1-72 of copending Application No. 09/573,727 or over claims 1-26 of copending Application No. 09/596,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are not patentably distinct from each other because the patented term electronic coupon or electronic coupon cookie or e-tail server or promotion code are obvious variations over the presently recited promotion.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Response to Arguments

Applicant's arguments filed June 12, 2003 have been fully considered but they are not persuasive.

requirement for information

Applicant's interpretation of Rule 105 requirement for information differs from current Office practice. The rule requires applicant to submit information (as outlined supra) to distinguish the applicant argued as patentable invention over the prior art as used in rejecting the claimed invention. In several instances, applicant argues that the claim language is not anticipated or obviated by the prior art discussed in the previous Office action, but does not submit the required information in order to patentably distinguish the invention from the prior art. A traversal is not considered an appropriate response to a requirement for information under Rule 105 under current Office practice.

non-statutory subject matter

The Office must interpret the claims broadly in light of terminology commonly used in the field of endeavor claimed by the applicant. The applicant is claiming a common promotion communication server network system, which does not require structural interaction. Broadly construed, a network of friends may meet to communicate through a spokesperson server for a promotion. For example, this system may include a group gathering within a work area or restaurant to celebrate a birthday or employment promotion including a server or servers singing happy birthday or hip-hip-hooray. This example is used to broadly construe the claimed invention in light of statute section 101.

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enablement and indefiniteness

Applicant argues those skilled in the art of computer programming would be able to make and use the claimed invention by reading the specification and referring to the associated drawings. However the claimed invention is not limited to the argued computer programming and the Office must interpret the invention in light of the specification. The invention is considered overly nebulously claimed; that one skilled in the art would be unable to make and/or use the invention based on either the specification or the claims itself. It is considered that the claimed invention is not in compliance with statute section 112 as discussed supra.

anticipation

Applicant interprets the argued rule 104 differently from current Office practice. Current Office practice incorporates the applicant emphasized, if not apparent, to mean that the claimed invention is apparent from each of the rejecting anticipatory references and therefore a clear explanation is not necessary. Applicant emphasizes that terms and statistics of various promotions are not anticipated from some of the anticipatory references. However, the applicant admits that the prior art teaches electronic card verification for particular purchases (Nitchberger) and particular product coupon printing at a point of sale (Off). Both of these teach involve the claimed terms (electronic card verification or particular product coupon printing) and the claimed statistics (for

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particular purchases or at a point of sale). Applicant's admission further shows that the claimed invention is clearly anticipated by the prior art.

obviousness

An examiner affidavit is to be submitted at the request of the applicant as an attachment to this Office action. Applicant argues that the Office motivation statement is hindsight reasoning, however it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In response to applicants request for clarification of the motivation to combine, the motivation is to show why the claimed invention would be obvious in light of automation of an old and well-known practice as demonstrated by examiner's experience.

double patenting

Applicant emphasizes that terms and statistics of various promotions are not obvious variation of applicant's copending applications. However as discussed above, those terms are broadly construed such that the Office may interpret applicant's copending claimed invention applications to allow appropriate double patenting. The argument that electronic coupon and promotion is patentably distinct from the claimed invention is not

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considered persuasive because those terms are merely an incentive for a user to purchase or consume a good or service. This incentive is claimed in the copending applications such that the present invention is an obvious variation and a double patenting rejection is considered appropriate.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is steve.gravini@uspto.gov. Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicant chooses to send information by e-mail, please be aware that confidentiality of the**

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electronically transmitted message cannot be assured. Please see MPEP 502.02.

Information may be sent to the Office by facsimile transmission. The Official Fax

Numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9306
Non-Official/Draft	(703) 872-9325

Steve Gravini
STEPHEN GRAVINI
PRIMARY EXAMINER

smg
September 8, 2003

Affidavit

Claims 1-27 are considered an obvious variation of examiner's personal experience of a method and system for telephone transactions from a Performance Bike Company (hereinafter Performance) sales catalog. Since at least 1994, examiner has experienced the method and system of Performance offering promotions associated with a store and commercially coupleable sales via a telephone such that each sales catalog contains a promotion code for shopper discounts. The claimed recitation including an authorization code, valuation and statistics of redeemed promotions, data display, and enablement. The claimed invention has been performed except for the recited servers, computer processors, and internet which are considered automated features of what is old and well known. Examiner takes Official notice that it is old and well known to those skilled in the art of a method and system for managing promotions over a network, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the expressed teachings of the examiner's experience. Furthermore examiner experience teaches the claimed invention except for the claimed automated features, such that the claimed invention is considered merely an automated feature of a concept that is old and well known as discussed above. The motivation to combine applicants claimed invention with the services offered by Performance is to allow advertisers greater consumer targeting capabilities through electronic mediums, while transferring electronic information, which clearly shows the obviousness of the claimed invention.

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I hereby declare that all statements made under this declaration of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under 18 USC 1001 and that such will false statements may jeopardize the validity of the application or any patent issued thereon.

Steve Davis